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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/325,533 06/03/99 HITCHCOCK

M F-01754-US1

025784

TM01/0612

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EXAMINER

SHAH, S

ART UNIT

PAPER NUMBER

2172

DATE MAILED:

06/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/325,533

Applicant(s)
Hitchcock et al.

Examiner
Sanjiv Shah

Art Unit
2172



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 3, 1999
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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Information Disclosure Statement

1. The information disclosure statement filed on 2/13/2001 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.
2. The information disclosure statement filed on 2/13/ 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Oath/Declaration

3. A new oath or declaration is required because the citizenship of one of the inventor is amended. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

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Specification

4. The abstract of the disclosure is objected to because it has more than one paragraph.

Abstract should be one paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scharmer (Patent # 5,640,577).

Regarding claims 1, 21, 32, 40 and 45, Scharmer et al. teaches the claimed invention of creating and processing forms representing applications as shown in fig 2A.

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creating a customized first form in response to user request and providing it to the user, entering the information in the information field is described in col. 5, lines 6-20.

posting the application on the server and storing the applicant information in the database is described in col. 2, lines 29-44 and col 5, lines 40-48.

Creating a second customized form for second applications program as described in col. 5, lines 60-67.

automatically inserting into some of the data fields of the second application from the data storage is described in col. 2, lines 50-65.

entering applicant information in the fields not automatically inserted is described in col. 6, lines 1-8.

posting second application from the server is described in col. 6, lines 37-46.

Scharmer teaches a forms for an applications as described in col. 2, lines 59-64. However it does not specifically teach an application for admission to the institution over the network. It is well known in the art to use a electronic form for admission to the institution over the network. An official notice is taken into this regard.

Therefore it would have been obvious for a person with ordinary skill in the art at the time the invention was made to use a well known method of creating an application form for admission to institution in the method of Scharmer because it provides online access to various institutions thus aiding in admission process.

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Regarding claims 2 and 3, Scharmer et al. teaches the claimed invention of generating a form according to stored preferences (see col. 2, lines 35-37) and modify the form without modifying the program. (see col. 4, lines 35-45).

Regarding claims 4, 5, 15, 22, 29, 33, 34, 43, 44, 48, 54 and 55, Scharmer et al. teaches the claimed invention of verifying the predefined criteria and information as described in col. 5, lines 41-47. The name and number is interpreted as the brand of institution as claimed.

Regarding claims 6, 14 and 27, Scharmer et al. teaches the claimed invention of predefined format as described in col. 2, lines 58-65.

Regarding claims, 7, 8 and 28, Scharmer teaches the claimed invention of online application analysis by various personnel as described in col. 7, lines 1-25.

Regarding claim 10, Scharmer teaches the claimed invention of paying application fees as described in col. 6, lines 37-50.

Regarding claims 9, 11, 12, 16, 25, 26, 41, and 47, Scharmer teaches the claimed invention of separately storing the elements for later retrieval as described in col. 5, lines 32-35.

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Regarding claim 13, Scharmer et al. teaches a form as shown in fig 3 and 4. Labels are shown as elements, Name, Addr, etc. The different fields are shown in fig 3A and 4A. Storing the information is independent of label.

Regarding claims 17, 30, 31, 35, 36, 42, 52 and 53, Scharmer teaches a data storage in a database as described in col. 5, lines 41-45. A use of relational database and XML is well known in the art. Therefore it would have been obvious of a person with ordinary skill in the art at the time the invention was made to use a relational database because it provides continuation information.

Regarding claim 18-20, 37-39 and 49-51, Scharmer et al. teaches the claimed invention of metadata as described in col. 4, Table I, element R, C, L.

Regarding claims 23 and 24, Scharmer et al. teaches a user definable function selector which is equivalent to claimed menus. Labels and menus is shown in fig 4B.

Regarding claim 46, Scharmer et al. teaches the method of overwriting with new values as described in col. 7, lines 53-63.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjiv Shah whose telephone number is (703) 305-8355.

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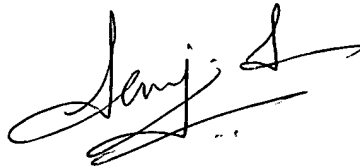
The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Kim Yen Vu can be reached at (703) 305-4393. The fax number for this group is (703) 308-5403.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305-9600.

Sanjiv Shah

June 9, 2001.

A handwritten signature in black ink, appearing to read 'Sanjiv Shah', with a stylized flourish extending from the end.

SANJIV SHAH
A.U. 2172